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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,663	07/02/2001	Antonio A. Garcia	A32011-A-PCT	2220
21003	7590	11/02/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			TRAN, MY CHAU T	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/807,663	<b>Applicant(s)</b> GARCIA ET AL.	
	<b>Examiner</b> MY-CHAU T TRAN	<b>Art Unit</b> 1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant's amendment filed 8/6/2004 is acknowledged and entered. Claims 1 and 5 have/has been amended.
2. Claims 10-23 were canceled and Claims 1 and 5 were amended by the amendment filed on 12/16/2003.
3. Claims 1-9 are pending.

### ***Priority***

4. This application is a 371 of PCT/US99/23,902 filed 10/14/1999, which claims priority to two provisional applications. They are 60/104,263, filed 10/14/1998, and 60/145,786, filed 7/27/1999.

### ***Maintained Rejections***

#### ***Claim Rejections - 35 USC § 112***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1639

The phrase “substantially transparent” of claim 1 and 5 is considered indefinite because it is unclear as to the means of measuring the degree of “substantially transparent” (i.e. how does one measure “substantially transparent”). Note that if the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. 112, second paragraph is appropriate. In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Siiman et al. (US Patent 5,552,086). (*Note: The rejection has been modified to address the new limitation of claim 1).*

*The instant claim 1 recites an apparatus (plate) comprise of silver ions immobilized on a support, wherein the plate is substantially transparent. The plate comprise of polystyrene plate (claim 2).*

Siiman et al. disclose a device that comprises a metal coated polymer support that is in a bioassay (col. 1, lines 32-36; col. 2, lines 50-61). The polymer includes polystyrene (col. 7, lines 35-38). The metal includes silver salt (col. 7, lines 49-57). The surface of the substrate comprises metal oxide state (col. 5, lines 25-28 and lines 42-45; col. 7, lines 49-57). The metal coating on the support would provide an advantage of enhancing light scattering with excitation in the visible light region (col. 2, lines 58-60). Additionally, the silver coated polystyrene

Art Unit: 1639

microspheres are coated onto the glass slide via a uniform coating (col. 13, lines 31-38).

Therefore, the device of Siiman et al. anticipates the presently claimed invention.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siiman et al. (US Patent 5,552,086) and Longiaru et al. (US Patent 5,232,829). (*Note: The rejection has been modified to address the new limitation of claim 1).*

*The instant claim 1 recites an apparatus (plate) comprise of silver ions immobilized on a support, wherein the plate is substantially transparent. The plate comprise of polystyrene plate (claim 2).*

Siiman et al. disclose a device that comprises a metal coated polymer support that is in a bioassay (col. 1, lines 32-36; col. 2, lines 50-61). The polymer includes polystyrene (col. 7, lines 35-38). The metal includes silver salt (col. 7, lines 49-57). The metal coating on the support would provide an advantage of enhancing light scattering with excitation in the visible light region (col. 2, lines 58-60).

The device of Siiman et al. does not expressly disclose that the support is in a plate format that is 96 wells.

Longiaru et al. disclose an immunoassay that comprise of a polystyrene solid support that has enhanced protein binding capacity (col. 3, lines 13-17; col. 6, lines 3-5). The polystyrene solid support is a microtitre plate with 96 wells (col. 7, lines 38-45). The plate capture format

Art Unit: 1639

would provide the advantages of a quicker assay time and a less labor intensive assay format (col. 3, lines 34-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a support in a plate format that is 96 wells as taught by Longiaru et al. in the device of Siiman et al. One of ordinary skill in the art would have been motivated to include a support in a plate format in the device of Siiman et al. for the advantage of a quicker assay time and a less labor intensive assay format (Longiaru: col. 3, lines 34-38) since both Kim et al. and Longiaru et al. disclose a polymer support is use in a bioassay (Siiman: col. 7, lines 35-38; Longiaru: col. 6, lines 3-5). Furthermore, one of ordinary skill in the art would have reasonably expectation of success in the combination of Siiman et al. and Longiaru et al. because the support in a 96 wells plate format is well known (i.e. commercially available) and routinely use for bioassay (col. 7, lines 38-45).

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (*Reactive Polymers*, 1994, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057).

Garcia et al. disclose an apparatus and the method of immobilizing silver ion on a polymer support for metal ion protein binding (Abstract; pg. 250, left col., lines 24-34, and right col., lines 17-43). The immobilization of the silver ion on the support comprises a two steps activation of the polymer support with glutaraldehyde and thiourea (pg. 250, right col., lines 22-43).

The apparatus of Garcia et al. does not expressly include a polymer support that is a polystyrene 96-wells plate.

Art Unit: 1639

Temeyer et al. disclose an immunoassay using a commercially available polystyrene plate (col. 7, lines 25-43). The polystyrene plate is activated using glutaraldehyde in order to attach the antigen (protein) onto the support.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a polymer support that is a polystyrene 96-wells plate as taught by Temeyer et al. in the apparatus of Garcia et al. One of ordinary skill in the art would have been motivated to include a polymer support that is a polystyrene 96-wells plate in the apparatus of Garcia et al. for the advantage of a support format that would provide a quicker assay time, and less labor intensive assay format since both Garcia et al. and Temeyer et al. disclose the method of attaching proteins to a polymer support (Garcia: pg. 250, left col., lines 24-34; Temeyer: col. 7, lines 25-29). Furthermore, one of ordinary skill in the art would have reasonably expectation of success in the combination of Garcia et al. and Temeyer et al. because the support in a 96 wells plate format is well known (i.e. commercially available) and routinely use for bioassay (col. 7, lines 38-45).

12. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (*Reactive Polymers*, 1994, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057).

Garcia et al. disclose an apparatus and the method of immobilizing silver ion on a polymer support for metal ion protein binding (Abstract; pg. 250, left col., lines 24-34, and right col., lines 17-43). The immobilization of the silver ion on the support comprises a two steps activation of the polymer support with glutaraldehyde and thiourea (pg. 250, right col., lines 22-43).

Art Unit: 1639

It is noted that the instant claims (claims 5-9) are written as product-by-process claims. “Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims is same or obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). (See MPEP 2113).

The apparatus of Garcia et al. does not expressly include a polymer support that is a polystyrene 96-wells plate.

Temeyer et al. disclose an immunoassay using a commercially available polystyrene plate (col. 7, lines 25-43). The polystyrene plate is activated using glutaraldehyde in order to attach the antigen (protein) onto the support.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a polymer support that is a polystyrene 96-wells plate as taught by Temeyer et al. in the apparatus of Garcia et al. One of ordinary skill in the art would have been motivated to include a polymer support that is a polystyrene 96-wells plate in the apparatus of Garcia et al. for the advantage of a support format that would provide a quicker assay time, and less labor intensive assay format since both Garcia et al. and Temeyer et al. disclose the method of attaching proteins to a polymer support (Garcia: pg. 250, left col., lines 24-34; Temeyer: col. 7, lines 25-29). Furthermore, one of ordinary skill in the art would have reasonably expectation of success in the combination of Garcia et al. and Temeyer et al. because the support in a 96



Art Unit: 1639

wells plate format is well known (i.e. commercially available) and routinely use for bioassay (col. 7, lines 38-45).

***Response to Amendment***

13. The declaration under 37 CFR 1.132 filed 8/6/2004 has been considered and entered. However, the declaration is insufficient to overcome the rejection under 35 U.S.C. 102(b) for claims 1-2 based upon the cited prior art of Siiman et al. (US Patent 5,552,086), and the rejections under 35 U.S.C. 103(a) based upon the cited prior arts of Siiman et al. (US Patent 5,552,086), Longiaru et al. (US Patent 5,232,829), Garcia et al. (*Reactive Polymers*, **1994**, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) as set forth in the last Office Action that are also reiterated above because:

- a. The declaration under 37 CFR 1.132 is insufficient to overcome the statutory bar, i.e. the rejections under 35 U.S.C. 102(b), with regard to the cited prior art of Siiman et al. (US Patent 5,552,086). (See MPEP § 706.02(b)).
- b. The objective evidence provided by Dr. Antonio A. Garcia in the declaration under 37 CFR 1.132 is inadequate to overcome the rejections under 35 U.S.C. 103(a) based upon the cited prior arts of Siiman et al. (US Patent 5,552,086), Longiaru et al. (US Patent 5,232,829), Garcia et al. (*Reactive Polymers*, **1994**, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) because there is no factual evidence supporting the objective evidence. That is the objective evidence fails to set forth facts that the bioassay plate of the cited prior art is structurally distinct from the presently claimed bioassay plate such as

a side-by-side comparison of the prior art bioassay plate and the instant claimed bioassay plate. (See MPEP § 716.01(c))

c. The objective evidence provided by Dr. Antonio A. Garcia in the declaration under 37 CFR 1.132 is inadequate to overcome the rejections under 35 U.S.C. 103(a) based upon the cited prior arts of Siiman et al. (US Patent 5,552,086), Longiaru et al. (US Patent 5,232,829), Garcia et al. (*Reactive Polymers*, **1994**, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) because the objective evidence is not relevant to the issue of nonobviousness of the claimed subject matter. That is the objective evidence that silver ions of the invention has the ability to bind to the biotin molecules which are attached to the antibodies or antigen used for an immunoassay wherein the binding occurs at the sulfur atom in the biotinylated antibodies is not relevant to the claimed subject matter since the claimed subject matter is an apparatus, i.e. a bioassay plate, comprising a support having silver ion directly immobilized thereon and the support is substantially transparent.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness. Thus, the declaration is insufficient to overcome the rejection under 35 U.S.C. 102(b) for claims 1-2 based upon the cited prior art of Siiman et al. (US Patent 5,552,086), and the rejections under 35 U.S.C. 103(a) based upon the cited prior arts of Siiman et al. (US Patent 5,552,086), Longiaru et al. (US Patent 5,232,829), Garcia et al. (*Reactive Polymers*, **1994**, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) as set forth in the last Office Action that are also reiterated above.

***Response to Arguments***

14. Applicant's argument directed to the rejection under 35 U.S.C. 112, second paragraph for claims 1-9 has been fully considered but they are not persuasive for the following reasons.

Applicant contends that "when read in light of the specification, the term "substantially transparent" is definite such that one of ordinary skill in the art would understand the meaning of the term as used in the claims" and cited case law of *Application of Swinehart*, 439 F.2d 214 (C.C.P.A. 1971), *Id.* at 2 14. Thus the phrase of "substantially transparent" is definite.

Applicant's arguments are not convincing since the phrase of "substantially transparent" is indefinite because 1) the instant specification, i.e. disclosure and/or figures, provides no standard for measuring that degree of transparency as claimed by the phrase of "substantially transparent" and 2) it is known in the prior art that bioassay plates are available commercially with varying degree of transparency, i.e. from opaque to clear bioassay plate. Thus one of ordinary skill in the art would not be able to ascertain the degree of transparency as claimed by the phrase of "substantially transparent", i.e. it is unclear what constitutes the metes and bound of the degree of transparency as claimed by the phrase of "substantially transparent". Additionally, cited case law of *Application of Swinehart*, 439 F.2d 214 (C.C.P.A. 1971), *Id.* at 2 14 would contradict applicant assertion since the instant specification, i.e. disclosure and/or figures, provides no standard for measuring that degree of transparency wherein the fact pattern of the case law cited that "*It is true that the figures reproduced in the specification indicate that the degree of transparency varies...*", i.e. the specification of *Application of Swinehart* provided the standard for measuring that degree of transparency. Therefore, the phrase of "substantially transparent" is indefinite and the rejection is maintained.

15. Applicant's arguments directed to the rejection under 35 USC 102(b) as being anticipated by Siiman et al. (US Patent 5,552,086) for claims 1-2 were considered but they are not persuasive for the following reasons.

Applicant argues that the apparatus of Siiman et al. do not anticipates the presently claimed apparatus because 1) Siiman et al. does not disclose that the silver ions be directly immobilized on the support, and 2) the silver ions of Siiman et al. are not complexed in a manner that makes them available for complexing with the sulfur atom in biotinylated antibodies wherein this assertion is supported by the declaration under 37 CFR 1.132. Thus the apparatus of Siiman et al. do not anticipates the presently claimed apparatus.

Applicant's arguments are not convincing since the apparatus of Siiman et al. do anticipates the presently claimed apparatus. First, Siiman et al. disclose that the silver ions are directly immobilized on the support (see col. 5, lines 25-28; col. 13, lines 31-38; col. 14, lines 18-20). 2) Applicant assertion that the silver ions of Siiman et al. are not complexed in a manner that makes them available for complexing with the sulfur atom in biotinylated antibodies is not relevant to the issue of the claimed apparatus for the "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).' (See MPEP 2114). Additionally, the declaration under 37 CFR 1.132 is insufficient to overcome this rejection because a declaration under 37 CFR 1.132 is insufficient to overcome the statutory bar. Thus, apparatus of Siiman et al. anticipates the presently claimed apparatus because it meets all the structural

Art Unit: 1639

limitations of the claimed apparatus, i.e. a support having silver ions directly immobilized thereon, and the rejection is maintained.

16. Applicant's arguments directed to the rejection under 35 USC 103(a) as being unpatentable over Siiman et al. (US Patent 5,552,086) and Longiaru et al. (US Patent 5,232,829) for claims 1-4 were considered but they are not persuasive for the following reasons.

Applicant contends that the combination of Siiman et al. and Longiaru et al. is not obvious over the presently claimed apparatus because 1) there is no expectation of success for the combination since the use of the apparatus of Siiman et al. would contradict the use of the apparatus of Longiaru et al., and 2) there is no motivation to combine the teaching of Siiman et al. and Longiaru et al. Therefore, the combination of Siiman et al. and Longiaru et al. is not obvious over the presently claimed apparatus.

Applicant's arguments are not convincing since the combination of Siiman et al. and Longiaru et al. is obvious over the presently claimed apparatus. First, there is a reasonable expectation to combining the teaching of Siiman et al. and Longiaru et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. Both Siiman et al. and Longiaru et al. teach a polystyrene support, i.e. analogous art, (see Siiman: col. 7, lines 35-38; Longiaru: col. 6, lines 3-5), and the combination of Siiman et al. and Longiaru et al. would produce an apparatus that would meets all the structural limitations of the claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. (See MPEP 2141.02). Thus there is reasonable expectation of success. Additionally, applicant assertion that

Art Unit: 1639

there is no expectation to combine because of how the apparatus in Siiman et al. and Longiaru et al. are use is not relevant to the issue of the claimed apparatus for the “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).’ (See MPEP 2114). Furthermore, the declaration under 37 CFR 1.132 is inadequate to overcome this rejection because there is no factual evidence supporting the objective evidence and the objective evidence is not relevant to the issue of nonobviousness of the claimed subject matter.

Second, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is found in the reference of Longiaru et al., the advantage of a quicker assay time and a less labor intensive assay format (Longiaru: col. 3, lines 34-38).

Thus, the combination of Siiman et al. and Longiaru et al. is obvious over the presently claimed apparatus because the combination of Siiman et al. and Longiaru et al. would produce the apparatus that would meets all the structural limitations of the claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon, and the rejection is maintained.

Art Unit: 1639

17. Applicant's arguments directed to the rejection under 35 USC 103(a) as being unpatentable over Garcia et al. (*Reactive Polymers*, **1994**, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) for claims 1-4 was considered but they are not persuasive for the following reasons.

Applicant alleges that the combination of Garcia et al. and Temeyer et al. is not obvious over the presently claimed apparatus because there is no expectation to combine the teaching of Garcia et al. and Temeyer et al. Therefore there is the combination of Garcia et al. and Temeyer et al. is not obvious over the presently claimed apparatus.

Applicant's arguments are not convincing since the combination of Garcia et al. and Temeyer et al. is obvious over the presently claimed apparatus because there is a reasonable expectation to combining the teaching of Garcia et al. and Temeyer et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. Both Garcia et al. and Temeyer et al. teach glutaraldehyde is bound to the polymer support and the method step of functionalizing the polymer support with glutaraldehyde, i.e. analogous art, (Garcia: pg. 250, left col., lines 24-34; Temeyer: col. 7, lines 25-29), and the combination of Garcia et al. and Temeyer et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. (See MPEP 2141.02). Thus there is reasonable expectation of success. Additionally, the declaration under 37 CFR 1.132 is inadequate to overcome this rejection because there is no factual evidence supporting the objective evidence and the objective evidence is not relevant to the issue of nonobviousness of the claimed subject matter. Thus, the combination of Garcia et al. and

Art Unit: 1639

Temeyer et al. is obvious over the presently claimed apparatus because the combination of Garcia et al. and Temeyer et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon, and the rejection is maintained.

18. Applicant's argument directed to the rejection under 35 USC 103(a) as being unpatentable over Garcia et al. (*Reactive Polymers*, 1994, 23(2-3):249-259) and Temeyer et al. (US Patent 4,945,057) for claims 5-9 was considered but they are not persuasive for the following reasons.

Applicant argues that the combination of Garcia et al. and Temeyer et al. is not obvious over the presently claimed apparatus because there is no expectation to combine the teaching of Garcia et al. and Temeyer et al. Therefore there is the combination of Garcia et al. and Temeyer et al. is not obvious over the presently claimed apparatus.

Applicant's arguments are not convincing since the combination of Garcia et al. and Temeyer et al. is obvious over the presently claimed apparatus because there is a reasonable expectation to combining the teaching of Garcia et al. and Temeyer et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. Both Garcia et al. and Temeyer et al. teach glutaraldehyde is bound to the polymer support and the method step of functionalizing the polymer support with glutaraldehyde, which is also claimed method step in the product-by-process claim of claim 5, i.e. analogous art, (Garcia: pg. 250, left col., lines 24-34; Temeyer: col. 7, lines 25-29), and the combination of Garcia et al. and Temeyer et al. would



produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon. (See MPEP 2141.02). Thus there is reasonable expectation of success. Additionally, the declaration under 37 CFR 1.132 is inadequate to overcome this rejection because there is no factual evidence supporting the objective evidence and the objective evidence is not relevant to the issue of nonobviousness of the claimed subject matter. Thus, the combination of Garcia et al. and Temeyer et al. is obvious over the presently claimed apparatus because the combination of Garcia et al. and Temeyer et al. would produce an apparatus that would meets all the limitations of the presently claimed apparatus, i.e. a 96-well polystyrene plate having silver ion directly immobilized thereon, and the rejection is maintained.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
October 28, 2004

  
PADMASREE PONDUGURI  
PRIMARY EXAMINER